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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,634	04/14/2004	Shinya Inagaki	826.1633D	4656
21171	7590	11/30/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				DOAN, JENNIFER
			ART UNIT	PAPER NUMBER
			2874	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/823,634	INAGAKI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jennifer Doan	2874	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 13 September 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 92-105 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 92-105 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 14 April 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. 09/753,573.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

The amendment, filed on September 13, 2005, has been considered and entered.

The Terminal Disclaimer, filed on September 13, 2005, was approved.

Claims 1-91 are canceled. Claims 92-105 are now pending.

The previous ground of rejection is now changed in this Office Action in response to the canceling claims 1-91 and newly adding claims 92-105. Since the new ground of rejection is necessitated by the amendment, this office action is made final.

### ***Specification***

1. Applicants' cooperation is requested in correcting any errors of which applicants may become aware in the specification.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 92, 96-98, 100, 104 and 105 are rejected under 35 U.S.C. 102(e) as being anticipated by Evangelides et al. (U.S. Patent 6,311,002).

With respect to claims 92 and 98, Evangelides et al. (Fig. 1) disclose an apparatus comprising a first compensator (106) compensating wavelength dispersion, the first compensator having a constant wavelength dispersion characteristic over a plurality of wavelengths (column 2, lines 26-33 and column 3, lines 20-33); and a second compensator (107) compensating wavelength dispersion after wavelength dispersion is compensated by the first compensator, wherein the first and second compensators together compensate for wavelength dispersion dependent on a respective wavelength of a transmission line (see figure 1).

With respect to claims 96 and 104, Evangelides et al. (column 3, lines 4-19) disclose an apparatus, wherein the respective wavelength is the wavelength of a respective signal light included in a wavelength division multiplexed (WDM) light transmitted through the transmission line and including a plurality of signal lights at different wavelength multiplexed together.

With respect to claims 97 and 105, Evangelides et al. (column 3, lines 10-12) disclose an apparatus, wherein the first compensator is a virtually imaged phased array (VIPA) dispersion compensator.

With respect to claim 100, Evangelides et al. (Fig. 1) disclose an apparatus comprising a first compensator (106) compensating for wavelength dispersion, the first compensator having a constant wavelength dispersion characteristic over a plurality of wavelengths (column 2, lines 26-33 and column 3, lines 20-33); and a second

compensator (107) compensating for dispersion slope over the plurality of wavelengths after the compensation by the first compensator (column 2, lines 4-7; column 3, lines 44-50 and column 3, line 65- column 4, line 3).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 93, 99 and 101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evangelides et al. (as cited above) in view of Yoshimura (U.S. Patent 5,793,917).

With respect to claims 93, 99 and 101, Evangelides et al. substantially disclose all the limitations of the claimed invention except for a housing which houses, and thereby encloses, both the first and second compensators.

However, Yoshimura (figure 3) discloses a housing (1) which houses the compensators for protection. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Evangelides with a housing to enclose the compensating device (accordance with the teaching of Yoshimura) for the purpose of obtaining more protection for the optical device.

7. Claims 94, 95, 102 and 103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evangelides et al. (as cited above) in view of Bergmann et al. (U.S. Patent 6,253,005).

With respect to claims 94, 95, 102 and 103, Evangelides et al. substantially disclose all the limitations of the claimed invention except for a substrate on which both the first and second compensators are fixed.

However, Bergmann et al. (figures 6 and 7) disclose a substrate on which the compensators (36) are fixed. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Evangelides with a substrate to fixedly hold the compensating device (accordance with the teaching of Bergmann et al.) for the purpose of obtaining more protection for the optical device.

***Obvious Type Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 92-105 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 12, 13, 15, 36-39 and 44 of U.S. Patent No. 6,744,958.

Although claims 92-105 of the present invention and claims 1-4, 12, 13, 15, 36-39 and 44 of U.S. Patent No. 6,744,958 are not identical, they are not patentably distinct from each other because they essentially recite the same the structure of compensation

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device compensating for wavelength dispersion. The claims are therefore *not* patentably distinct.

***Response to Arguments***

10. Applicants' argument filed on April 18, 2005 has been fully considered.

Please refer to claim rejection above for newly added claims 92-105.

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Doan whose telephone number is (571) 272-2346. The examiner can normally be reached on Monday to Thursday from 6:00 am to 3:30 pm, second Friday off.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on (571) 272-2344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jennifer Doan

Patent Examiner

November 22, 2005